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In the Supreme Court of the United States

OCTOBER TERM, 1953

No. 403

ANNETTE S. LUNN,
Petitioner,

vs.

F. W. WOOLWORTH COMPANY,
Respondent.

Brief for Respondent in Opposition to Petition for Writ of Certiorari

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OPINIONS BELOW

The opinion of the Court of Appeals for the Ninth Circuit was reported in ..... F(2) ....., 98 U.S.P.Q. 184 (R. 368-373). The decision of that court reversed a judgment on a jury verdict and the denial of a motion for a directed verdict, such denial being unreported (R. 71, 233). A Petition for Rehearing was denied (R. 375).

JURISDICTION

Jurisdiction of this Court is based upon Title 28, U. S. Code, Section 1254 (1), the Petition having been filed in accordance with Title 28, U. S. Code, Section 2101 (c).

STATEMENT OF THE CASE

Petitioner's statement of the case generally emphasizes the points favorable to her. The following additional points should be noted.

Petitioner complains that the Court of Appeals erred in determining that the patent was invalid because of *lack of novelty,* as well as lack of invention, and the Petition (page 17) contains the bald and erroneous statement that:

> "The motion for a directed verdict was directed *only* to the issue of invention."[1]

This matter is brought to the Court's attention because respondent-defendant's motion for a directed verdict was actually made on the basis of "lack of patentability" (R. 231, 36-37), which includes *both* lack of novelty and lack of invention. This same motion was restated and denied after the verdict came in (R. 34).

It is further noted that, although the trial judge indicated his agreement with the jury's verdict *at the time it was brought in* (R. 33), when he later reconsidered the denial of the motion for a directed verdict, he cited and relied upon only a single decision (R. 71): *Packwood v Briggs & Stratton Corp. et al.,* 99 F. Supp. 803 (D.C. Del., 1951). This case was one where a trial judge, stating that he thought the jury wrong in holding the patent valid, held that he did not

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1. Italics throughout this Brief may be considered ours.

have the *power* to direct a verdict in a patent case. This same case has now been reversed by the Court of Appeals for the Third Circuit which said that he had not only the power but the *duty* to direct the verdict where the patent was clearly invalid. *Packwood v. Briggs & Stratton Corp. et al.*, 195 F(2) 971 (C.A. 3, 1952). Certiorari was subsequently denied, 344 U.S. 844, 73 S.Ct. 61, reh. den. 344 U.S. 882, 73 S.Ct. 174.

SUMMARY OF ARGUMENT

Although the argument takes many forms, the gist of the present Petition is that the Court of Appeals, in holding that Respondent's motion for a directed verdict should have been granted, deprived Petitioner of the jury trial guaranteed by the Seventh Amendment.

The short answer to this contention is that no such guarantee exists where *the patent is invalid as a matter of law.*

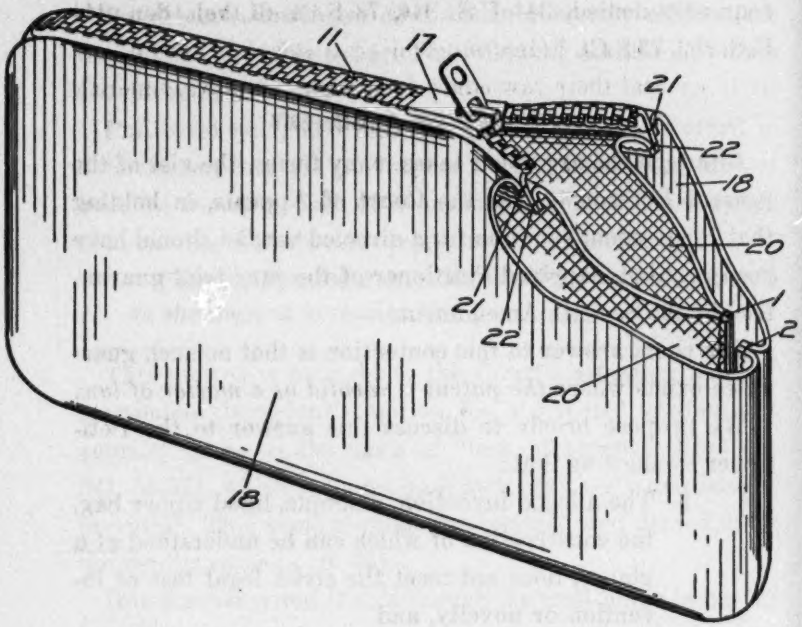
We propose briefly to discuss this answer to the Petitioner by showing that:

1. The alleged invention, a simple, lined zipper bag, the construction of which can be understood at a glance, does not meet the strict legal test of invention or novelty, and
2. In such circumstances, patent validity is a question of law; and there are no questions of fact for submission to a jury.

ARGUMENT

Petitioner's Simple Device Cannot Meet This Court's Strict Test of Invention.

That the alleged invention of the patent in suit is extremely simple and requires no explanation for its understanding is obvious from the following sketch:



The patent shows a simple zipper hand bag comprised of four elements, an outer material 18[1], a lining material 20, a zipper 11, 17 and stitching 1, 2, 21, and 22 for securing

1. Numerals used, so far as possible, are those used in the patent (R. 78, 291-294).

the various elements together. Only one claim[1] is involved, and Petitioner admits that its every element is old and that it is only the combination of elements which is alleged to be new or novel (R. 131; Petition, pages 6-7).

The prior art, though extensive, need not be considered in detail. The McGuire patent (R. 156-7, 356-9, 151) shows all four of the elements of the bag and shows that the outer material and the lining material are stitched in such a way as to conceal their raw edges (see Figs. 2 and 3; numerals 17 and 25). And both the Maksik (R. 157-8, 360-2, 151) and Moore (R. 158, 329-331, 151) patents show all of the four elements with the stitching arranged to conceal the raw edges of the zipper tape.

Since there is no dispute concerning what is shown in the patent and in the prior art, the only real question before this Court is whether Petitioner's trivial change amounts to invention. We submit that, tested by this Court's opinion in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. et al.*, 340 U.S. 147, 71 S.Ct. 127 (1950), reh. den. 340 U.S. 918, 71 S.Ct. 349, the device in issue wholly

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1. Claim 4 reads as follows (R. 294):

"A bag of the character described comprising an outer material, a lining material and a slide-fastener closure member including tape members for attachment to the materials of the bag, stitching connecting said tape members to said outer and lining materials, said outer material forming side members for the bag and being connected together by stitching at the side edges thereof, said lining material forming side members for the bag and being connected together by stitching at the side edges thereof, all of the raw edges of the seams formed by said stitching being concealed between the outer material and the lining material."

and completely fails to qualify. The test is as follows (page 130):

> "* * * *This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned,*[1] and there is nothing to indicate that the lower courts scrutinized the claims in the light of this rather *severe* test.
>
> "* * * *Two and two have been added together, and still they make only four.*
>
> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. *The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men.* This patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly."

This is indeed a strict standard, and when the device in issue is thus measured, it is clearly wanting. No better proof of this can be found than in Petitioner's own testimony (R. 86-87, 101), where she could point to no advantages over the prior art excepting that the bag was "nicely finished" and

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1. The trial court refused to use the language of this test of invention in its instructions, remarking that, "* * * to a jury it may be misleading!" (R. 255). An exception was taken (R. 257).

had "fine tailoring." On direct examination, she testified (R. 86-87):

> "Q. Would you tell us what advantages, if any, that you thought your invention had over those of which you had knowledge, the other types of bags then on the market?
>
> "A. I can only answer, our buyers told us that it was a lovely bag for the price, nice clean finish, and that they had never seen a bag made like that before."
>
> * * * * * * *
>
> "Mr. Townsend: Q. Mrs. Lunn, I hand you Plaintiff's Exhibit 4 [Petitioner's bag], and ask you if you could briefly explain to the jury what features of construction you think were important at that time.
>
> "A. Well, Exhibit 4, I just want to show you how nicely it was finished. That is what took the buyer's eye is the finish of the bag. It was all neatly finished and they hadn't seen one on the market before. The inside looked exactly like the outside. Absolutely no stitching showed anywhere. That is what sold the bag to the buyers."

If the Petitioner's improvement admittedly consists in nothing more than a bag with a "nice clean finish," we submit that it is wholly lacking in invention, for, like the device involved in the *Great Atlantic & Pacific Case*, supra, it

> "* * * is wanting in any unusual or surprising consequences from the unification of the elements here concerned * * *"

Although Petitioner may have developed a bag with a neat and attractive appearance, it obviously has no unusual or surprising features; and a glance at the above sketch is convincing that the alleged inventive step was a trivial one which might well have been made by any ordinary seamstress.

The Right of a Judge to Direct a Verdict in a Patent Case.

We may quickly pass over Petitioner's general and extensive, if not entirely clear, attack on the right of a court to grant a directed verdict or a judgment n.o.v. The "short answer is the contention has been foreclosed by repeated decisions made here consistently for nearly a century." *Galloway v. United States,* 319 U.S. 372, 63 S.Ct. 1077, 1086 (1943), reh. den. 320 U.S. 214, 63 S.Ct. 1443.

Very little more need be said when the contention is related specifically to patent cases. Not only does Petitioner almost wholly ignore the only four recent decisions[1] of the Courts of Appeal which discuss, and vigorously affirm, this right, but she wholly fails to support her repeated suggestion of "probable" conflict in the decisions (Petition, pages 12-13).

Furthermore, the trial court's right, in view of the Seventh Amendment, to direct a verdict in a patent case does not raise any question of great import. Were this not so, this Court would not have denied certiorari last term in the *Packwood Case,* just cited, where it had the opportunity to consider the question, nor would it have denied certiorari in the *Ryan*[2] and *Refrigeration Patents Cases,* also just

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1. *Ryan Distributing Corporation v. Caley,* 147 F(2) 138 (C.C.A. 3, 1945), cert. den. 325 U.S. 859, 65 S.Ct. 1199; *Refrigeration Patents Corporation v. Stewart Warner Corporation,* 159 F (2) 972 (C.C.A. 7, 1947), cert. den. 331 U.S. 834, 67 S.Ct. 1515; *Packwood v. Briggs & Stratton Corp. et al.,* 195 F(2) 971 (C.A. 3, 1952), cert. den. 344 U.S. 844, 73 S.Ct. 61; *Himes et al. v. Chadwick,* 199 F(2) 100 (C.A. 9, 1952). These cases are merely cited by Petitioner in a long list of cases (Petition, pages 49-50).

2. This opinion contains the answer to Petitioner's repeated contention that the "presumption of validity" was sufficient to preclude a directed verdict (Petition, pages 22, 31-32, 44-46). The Court of Appeals flatly held that the "presumption of validity does not necessitate the submission of the question of invention to the jury if the patent appears to the court to be plainly invalid" (147 F(2) 138, 141).

cited, in which the protection of the Seventh Amendment was strenuously and unsuccessfully urged upon this Court.

The right to direct a verdict in a patent (or any other type) case depends upon whether we are concerned with a question of fact or a question of law. Since the earliest times, this Court has been plagued with petitions to decide whether the validity of a patent is a question of fact or law. But also, since the earliest times, *this Court has consistently held that when the facts are little in dispute and no conflict in testimony is involved, the validity of a patent is a question of law.* This Court's latest statement of this well established rule was in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. et al.,* 340 U.S. 147, 71 S.Ct. 127 (1950), reh. den. 340 U.S. 918, 71 S.Ct. 349, in which case, Justices Douglas and Black, in a concurring opinion, went even further and held it to be a question of law *in all cases.* 340 U.S. 155, 71 S.Ct. 132.

In the present case, these separate views need not be considered, for here *the Petition makes no contention that the facts are in dispute or that there is any necessity to resolve any conflict in the testimony.* As a consequence, this is clearly a case where patentability is to be treated as a question of law. The pertinent rule is well stated in the leading case of *United States v. Esnault-Pelterie,* 303 U.S. 26, 58 S.Ct. 412 (1938), where the Court said at pages 414-415:

> "• • • where, with all the evidence before the court, it appears that no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structures and extrinsic evidence is not needed for purposes of explanation, or evaluation of

prior art, or to resolve questions of the application of descriptions to subject matter, *the questions of invention and infringement may be determined as questions of law.* Heald v. Rice, 104 U.S. 737, 749, 26 L. Ed. 910; Singer Mfg. Co. v. Cramer, 192 U.S. 265, 275, 24 S.Ct. 291, 48 L. Ed. 437; Sanitary Refrigerator Company v. Winters, 280 U.S. 30, 36, 50 S.Ct. 9, 10, 74 L. Ed. 147."

Applying this rule, in an appeal from the denial of a motion to direct the verdict in a patent case, this Court, in *Market Street Cable Railway Company v. Rowley,* 155 U.S. 621, 15 S.Ct. 224 (1895), reversed the trial court, emphasizing, at pages 625-630, that the trial court had the *duty* to so direct the verdict:

"Did the court below err in refusing to instruct the jury to find a verdict for the defendant on the ground that the patent sued on was void for want of novelty?

"The defendant put in evidence a number of patents prior in date to the plaintiff's and asked the court to compare the inventions and devices therein described with those claimed by the plaintiff. No extrinsic evidence was given or needed to explain terms of art, or to apply the descriptions to the subject-matter, so that the court was able, from mere comparison, to say what was the invention described in each, and to affirm from such mere comparison whether the inventions were or were not the same. *The question was, then, one of pure construction and not of evidence, and consequently was matter of law for the court, without any auxiliary fact to be passed upon by the jury.*

"If upon the state of the art as shown to exist by the prior patents, and upon a comparison of the older devices with those described in the patent in suit, it should appear that the patented claims are not novel, *it becomes the duty of the court to so instruct the jury.*

Powder Co. v. Powder Works, 98 U.S. 126; Heald v. Rice, 104 U.S. 737, 749; Fond du Lac County v. May, 137 U.S. 395."

* * * * * * *

"In view, then, of the state of the art as manifested by several prior patents, we think it is plain that the patent of Lyon and Munro is void for want of patentable novelty, and that the court below erred in not so instructing the jury."[1]

Thus, when there is no conflict of testimony, no question arises relative to the court's setting aside any question of fact—for none is involved. The real point is whether, considering the clear showing of the patent and the prior art, the margin of difference rises to the dignity of invention.

Basically, this the same question was presented to this Court in *Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp. et al.,* 340 U.S. 147, 71 S.Ct. 127 (1950), reh. den. 340 U.S. 918, 71 S.Ct. 349, and in *Crest Specialty v. Trager et al.,* 341 U.S. 912, 71 S.Ct. 733 (1951). In the first case, it was argued that this Court (or an appellate court) could not set aside a finding of invention made by the trial court. This contention was completely answered as follows, at page 131:

"The questions of general importance considered here are not contingent upon resolving conflicting testi-

1. Petitioner attempts to label this case an "exception" (Petition, page 36) and states that it is distinguishable from the one at bar because here there was "extrinsic evidence." If this is an attempt to argue that the patent and prior art needed explanation the answer is found in their obvious simplicity. Furthermore, this same argument has been found entirely wanting where the patents involved were simple and clear and such extrinsic evidence was unnecessary. *Great Atlantic & Pacific Tea Co. v Supermarket Equipment Corp. et al.,* supra; *Crest Specialty v. Trager et al.,* 341 U.S. 912, 71 S.Ct. 733 (1951).

mony, for the facts are little in dispute. *We set aside no finding of fact as to invention, for none has been made except as to the extension of the counter, which cannot stand as a matter of law. The defect that we find in this judgment is that a standard of invention appears to have been used that is less exacting than that required where a combination is made up entirely of old components. It is on this ground that the judgment below is reversed.*"

This statement contains the crux of the matter—*it is the standard of invention which controls.* And it is this principle which the only two Courts of Appeal very recently considering the question have followed in approving the setting aside of jury verdicts in *patent cases* where the proper standard has been ignored. *Packwood v. Briggs & Stratton Corp. et al.*, 195 F(2) 971 (C.A. 3, 1952), cert. den. 344 U.S. 844, 73 S.Ct. 61; *Himes et al. v. Chadwick*, 199 F(2) 100 (C.A. 9, 1952). In the latter of these two cases, the Court of Appeals for the Ninth Circuit followed the decision in the former and emphatically approved the granting of a judgment n.o.v.; in the former, the Court of Appeals for the Third Circuit reversed the trial judge's ruling that he did not have the *power* to grant a judgment n.o.v. in a patent case.[1] In a well reasoned opinion, the court held

1. In view of Petitioner's repeated emphasis (Petition, pages 3, 14, 45) that the trial judge here approved the jury's verdict, *at the time it was returned*, this Court must consider that in denying Respondent's motion for a directed verdict and judgment n.o.v., the trial judge relied on only one case, the (now reversed) lower court's opinion in the *Packwood Case* (99 F. Supp. 803, 807), wherein the trial judge stated that "If I had the *power* to decide, I would hold the patent in suit invalid without much delay." It would appear that by the time the trial judge here came to decide the motions, he could have found *substantially* better authority for denial if he were still convinced of the patent's validity.

that he not only had the power to do so, but emphasized that it was his *responsibility and duty* (pages 973-974):

> "This finding of invention and validity was very clearly wrong. *A jury in a patent case is not free to treat invention as a concept broad enough to include whatever discovery or novelty may impress the jurors favorably.* Over the years the courts of the United States, and particularly the Supreme Court, have found meaning implicit in the scheme and purpose of the patent laws which aids in the construction of their general language. In this process, rules and standards have been developed for use as guides to the systematic and orderly definition and application of such a conception as invention in accordance with what the courts understand to be the true meaning of the Constitution and the patent laws. *Once such standards and rules are authoritatively announced any finding of 'invention' whether by a court or a jury must be consistent with them.*
>
> "This is no peculiarity of patent law. Jury findings of negligence or proximate cause must comport with common law rules devised to give reasonable and systematic meaning to those generalities. For such rules, see Restatement of the Law, Torts, Negligence, Chs. 12-16. And so it is throughout the body of the common law. *This authority and responsibility to keep jury findings within reasoned rules and standards is an essential function of United States judges today as it long has been of common law judges.* See Capital Traction Co. v. Hof, 174 U.S. 1, 13-16, 19 S.Ct. 580, 43 L. Ed. 873 (1899). *It stands as a great safeguard against gross mistake or caprice in fact finding.*"
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> • • • • • • •
>
> "In Ryan Distributing Corp. v. Caley, 3 Cir., 1945, 147 F.2d 138, 142, this court pointed out that *entry of judgment n.o.v. is the appropriate corrective action*

when a jury has found a patent valid although the court's application of defining principles reveals 'a clear-cut case of lack of invention.' Also indicating the propriety of thus overruling the trier of fact is the already cited Atlantic and Pacific case where the Supreme Court reversed a finding of invention duly made and approved by both a district court and a court of appeals. In the instant case the district court should have entered judgment n.o.v. upon the basis of a ruling that, consistent with *controlling standards,* the device in suit plainly could not embody invention."

Accord and followed in: *Fraver v. Studebaker Corp.,* 112 F. Supp. 209 (D.C. Pa., 1953); *Fischer & Porter Company v. Brooks Rotameter Co.,* 107 F. Supp. 1010 (D.C. Pa., 1952).

In the final analysis, then, Petitioner's difficulty arises from her failure to appreciate that any jury finding of invention must be "consistent with controlling standards." The yardstick against which invention is measured, like many other legal doctrines, is one established by the *courts* as a matter of law; the jury's only function is to set the improvement alongside that yardstick and make the necessary comparison, as a matter of fact. But if, in doing so, "a standard of invention appears to have been used less exacting than that required," the verdict is defective[1] and the "entry of judgment n.o.v. is the appropriate corrective action [because the] jury has found a patent valid although the court's application of defining principles reveals 'a clear-cut case of lack of invention'."[2]

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1. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. et al., supra.*

2. *Ryan Distributing Corporation v. Caley, supra; Packwood v. Briggs & Stratton Corp. et al., supra.*

Petitioner therefore must look in vain for sympathetic ears to heed her cry that she has here been deprived of her right to a jury trial. That right is no more sacred than Respondent's counterbalancing right to have *its* cause judged according to the established rules of law. As stated in *Galloway v. United States,* 319 U.S. 372, 63 S.Ct. 1077 (1943), Petitioner's position, which essentially denies *any* review of jury verdicts, imposes too great a risk on defendant. The Court said, at page 1088:

> "* * * The true effect of imposing such a risk would *not* be to guarantee the plaintiff a jury trial. It would be rather to deprive the defendant * * * of the right to challenge the legal sufficiency of the opposing case. The [7th] Amendment was not framed or adopted to deprive either party of either right. It is impartial in its guaranty of both. To posit assertion of one upon sacrifice of the other would dilute and distort the full protection intended."

CONCLUSION

We have attempted to analyze what we consider to be the basic misconception of the Petition. There is no question that Petitioner has a right to a jury trial; likewise there is no question that a defendant has a right to have its own case shielded against a verdict based on the misapplication of established legal principles.

Petitioner's handbag is nothing more than a trivial change over the prior art. Its nice finishing and tailoring obviously appealed to the jury—but this was not invention. It is just this kind of an appeal to a jury which a motion for a directed verdict is intended to overcome. Thus, when the

jury departed from the established legal criteria of patentability, it was both the duty and the responsibility of the trial judge to direct the verdict. Having failed to do so, the Court of Appeals had no recourse but to reverse the judgment.

We earnestly and sincerely urge that the Petition for the Writ should be denied.

Respectfully submitted,

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Petitioner's Reply Brief in Support of Petition for Writ of Certiorari

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Instead of answering the matters urged in the petition, the respondent seeks to justify the action of the Court of Appeals by arguing that there was evidence to support a finding of invalidity; by pointing out that other courts have permitted the directions of verdicts in other jury patent cases; by alluding to dictum in Supreme Court decisions; and by urging that prior denials of certiorari prove that

the Seventh Amendment does not raise "any question of great import."

The fact, if it be true, that evidence might have supported an original verdict of invalidity, does not control the matter. The proper test in the Court of Appeals was whether the evidence supported an original verdict of validity because the jury found in favor of plaintiff.

The fact, if it be true, that several lower court decisions would have justified the action of the Court of Appeals, likewise does not control the matter. Petitioner has asked review so this Court can resolve the conflict in the decisions in the lower courts.

Likewise, the Supreme Court cases which respondent cites do not control the matter. None of them resolves the conflict of law which petitioner has asked this Court to decide.

RESPONDENT'S BRIEF IGNORES THE GROUNDS FOR THE PETITION

In seeking certiorari, petitioner pointed out that the decision of the Court of Appeals was in conflict with the Seventh Amendment (Ground 1(a), pages 12-13, 26-41); that the opinion was in conflict with controlling California law (Ground 1(b), pages 13, 41-46); that lack of novelty was not properly before the Court of Appeals (Ground 2, pages 13, 46-47); that this Court has never decided the conflict of decisions ruling on the direction of a verdict in a patent infringement action (Ground 3, page 13, 47-50) and that jurisdiction of the Court of Appeals on petitioner's appeal was statutory (Ground 4, page 14, 51-52).

Of all of these grounds, the only one which respondent answers is that it believes that the question of lack of

novelty was properly before the Court on the motion for judgment notwithstanding the record (Respondent's brief, page 2). Petitioner respectfully submits that if this Court will read the motion for directed verdict appearing at pages 231-232 of the record, that this Court will perceive that the respondent discussed lack of invention and not lack of novelty in support of its motion. The broad catch-all of "lack of patentability" upon which respondent relies (Respondent's brief, page 2) should be read in the light of the entire motion. The entire motion makes clear that the specific issue of lack of novelty was never raised.

The nature of respondent's arguments is discussed under separate chapter headings following this introduction.

RESPONDENT'S BRIEF DEMONSTRATES THE CONFLICT OF EVIDENCE

Petitioner pointed briefly to evidence on the merits of the controversy which supports the verdict of the jury (pages 17-26). The respondent points to evidence which perhaps would have lent support to an original verdict for the defendant had the jury agreed with defendant. The alleged closeness of the prior art (Respondent's brief, page 5); the alleged simplicity of the bag (Respondent's brief, page 4); and the antiquity of the separate elements (Respondent's brief, page 5) are all matters which the jury weighed in reaching its conclusion.

A patent case is no different than any other jury action.* In each case, the jury must weigh conflicting inferences to

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*_Root v. Lake Shore and Michigan Southern Railway Company_ (1882) 15 Otto (105 U.S.) 189, 206, 26 L.Ed. 975, 981 (cited petition, page 29) and _Packwood v. Briggs & Stratton Corp. et al._ (C.A. 3, 1952) 195 F(2d) 971, 973 (cited respondent's brief, pp. 12-13).

be drawn from the evidence. On review, the question is not whether there was evidence contra the verdict of the jury. The real question is whether there was evidence in support of the verdict of the jury.

That this is the true criterion of review in any jury action appears from the cases of *Lavender v. Kurn* (1946) 327 U.S. 645, 653, 90 L.Ed. 916, 923, and in *Myers v. Reading Co.* (1947) 331 U.S. 477, 485, 91 L.Ed. 1615, 1620, where the Court said:

> "• • • But where, as here, there is an evidentiary basis for the jury's verdict, the jury is free to discard or disbelieve whatever facts are inconsistent with its conclusion. And the appellate court's function is exhausted when that evidentiary basis becomes apparent, it being immaterial that the court might draw a contrary inference or feel that another conclusion is more reasonable."

THE LOWER COURT DECISIONS CITED BY RESPONDENT DO NOT RESOLVE THE CONFLICT

Respondent seeks to justify the action of the Court of Appeals in directing a verdict in favor of the defendant by citing the following authorities:

Fischer & Porter Company v. Brooks Rotameter Co., 107 F. Supp. 1010 (D.C. Pa., 1952) cited page 14;

Fraver v. Studebaker Corp., 112 F. Supp. 209 (D.C. Pa., 1953) cited page 14;

Himes et al. v. Chadwick, 199 F.(2) 100 (C.A. 9, 1952) cited pages 8, 12;

Packwood v. Briggs & Stratton Corp. et al., 195 F.(2) 971 (C.A. 3, 1952) cited pages 3, 8, 12, 14;

Refrigeration Patents Corporation v. Stewart Warner Corporation, 159 F.(2) 972 (C.C.A. 7, 1947) cited page 8; and

Ryan Distributing Corporation v. Caley, 147 F.(2) 138 (C.C.A. 3, 1945) cited pages 8, 14.

The question of whether or not these cases support the action of the Court of Appeals in the case at bar should not control this Court's exercise of its discretion. This Court alone can finally determine what are the true rules of law. The only consideration of controlling importance is whether the correct rule of review is the one applied in the six lower court decisions cited by respondent or whether it is the one applied in the authorities cited by petitioner at pages 48-49 of its petition. Indeed, one of the grounds urged by petitioner is that a conflict does exist and that this Court should decide the conflict (Petitioner's brief, pages 47-50). Respondent does not deny the conflict and advances no reason why this Court should not resolve it.

THE CONFLICTS ARE NOT RESOLVED BY DECISIONS IN THIS COURT

In opposition to the petition, the respondent points to five authorities of this Court listed below:

Crest Specialty v. Trager et al., 341 U.S. 912, 71 S.Ct. 733 (1951) cited page 11;

Galloway v. United States, 319 U.S. 372, 63 S.Ct. 1077 (1943) cited pages 8, 15;

Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. et al., 340 U.S. 147, 71 S.Ct. 127 (1950) cited pages 5, 7, 9, 11, 14;

Market Street Cable Railway Company v. Rowley, 155 U.S. 621, 15 S.Ct. 224 (1895) cited page 10; and *United States v. Esnault-Pelterie,* 303 U.S. 26, 58 S.Ct. 412 (1938) cited page 9.

These cases do not decide either the conflict between the Seventh Amendment and the decision of the Court of Appeals in the case at bar, or the conflicts between the several different decisions in the courts below.

The *Crest Specialty* and *Great Atlantic & Pacific* cases do not even purport to discuss the effect of the Seventh Amendment and the place of a jury verdict in a patent infringement action. This, because both cases arose on actions tried by a court sitting without a jury. The review of non-jury cases is not governed by the Seventh Amendment. This appears from *Thomson Spot Welder Co. v. Ford Motor Co.* (1924) 265 U.S. 445, 446, 68 L.Ed. 1098, 1100, and *United States v. United States Gypsum Co.* (1948) 333 U.S. 364, 395, 92 L.Ed. 746, 766. The petition mentions these two cases in support of the distinction between the two forms of review (page 16), a matter which respondent does not genuinely dispute.

The *Esnault-Pelterie* case likewise does not purport to dispose of the conflict. The language upon which the respondent relies (Respondent's brief, pages 9-10) is a dictum. The matter was before this Court on findings of the trial court sustained on review rather than on the verdict of a jury reversed on review. Under the authority of such cases as *Cohens v. Virginia* (18-21) 6 Wheat. (19 U.S.) 264, at page 399, 5 L.Ed. 257, at page 290, a dictum should not

control the judgment in a subsequent case where the specific point under consideration is presented for decision.

Similarly the *Market Street Railway* case does not dispose of the issues in the case at bar. As appears from the quotation relied on by respondent (Respondent's brief, page 10), the only issue was novelty, and extraneous evidence was neither given nor needed to explain terms of art or to apply the descriptions to the subject matter in issue. In the case at bar, the testimony of the defendant's expert was required to interpret the disclosures of the prior art. Moreover, in the *Market Street* case this Court did not direct the entry of judgment notwithstanding the verdict, but on the contrary ordered a new trial.

This leaves only the *Galloway* case (Respondent's brief, pages 8 and 15) in which the question was whether the successful plaintiff had met his burden of proof in claiming permanent disability. That case likewise does not resolve the conflicts in the case at bar. In that case, the verdict of the jury was based entirely upon mere speculation. In the case at bar, the verdict was supported not only by the presumption of patent validity, but also by affirmative evidence supporting the presence of patentable novelty under long established affirmative tests of invention (Petition, pages 22-26). Further, as distinguished from the *Galloway* case, the defendant Woolworth had the burden of proof on the issue of validity.

THE DENIAL OF CERTIORARI IN PRIOR JURY PATENT CASES IS WITHOUT SIGNIFICANCE

Respondent urges, pages 8-9, that the effect of the Seventh Amendment "does not raise any question of great

import." The reason given is that this Court would not have denied certiorari in certain cited jury patent cases "were this not so."

This Court reasons to the contrary. Its view is that denial of certiorari imports no expression of opinion upon the merits of the case (as shown, for example, in *U. S. v. Carver* (1923) 260 U.S. 482, 490, 67 L. Ed. 361, 364). And *House v. Mayo* (1944) 324 U.S. 42, 48, 89 L. Ed. 739, 743, holds that denial of certiorari is not an expression "of the opinion that no meritorious question is presented by the matters of which petitioner here complains."

This Court has also said, in speaking of prior denials in *Maryland v. Baltimore Radio Show* (1950) 338 U.S. 912, 94 L. Ed. 562, pp. 918, 566:

"Wise adjudication has its own time for ripening."

Petitioner submits that the "time for ripening" is here when a Court of Appeals overrides the Seventh Amendment to the Constitution to the point that it ignores all evidence supporting the verdict of the jury, to the point that it ignores the presumption of validity,* and to the point that it ignores the rule that the infringer has the burden of proof on the issue of validity.* When a reviewing court departs thus far from the Seventh Amendment, then the question should, indeed, be deemed one of "great import."

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*Congress has adopted the sound public policy of these two Court announced rules in the new patent codification, U.S. Code, Title 35, Section 282.

CONCLUSION

In conclusion, petitioner submits that a petition for a writ of certiorari should be granted. There is a real conflict between the Seventh Amendment and the cases upon which respondent relies. There is also a real conflict between the lower court decisions giving weight to a jury verdict and the authorities upon which the respondent relies. In the interest of stability in the law, these conflicts should be resolved. It is only through the grant of certiorari in this or in some similar jury action that patentees and patent litigants may be advised as to the effect of the Seventh Amendment in patent litigation. As petitioner pointed out in her petition, justice may be had by the grant of the petition in this case.

Respectfully submitted,

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